REMARKS

Applicants appreciatively acknowledge the Examiner's confirmation of receipt of applicants' claim for priority under 35 U.S.C. § 119(a)-(d). The Examiner noted that applicant has not filed certified copies of the priority applications as required by 35 U.S.C. § 119(b).

Applicants acknowledge the requirement, have ordered the certified copy, and will file the claim for priority with the document as soon as possible.

Reconsideration of the application is requested.

Claims 9 to 16 remain in the application. Claim 9 has been amended.

In item 1 on page 2 of the above-identified Office Action, the Examiner objected to the specification because of an informality. Corrections have been made to this informality and to other formal aspects of the specification. No new matter has been added.

In item 3 on pages 2 to 3 of the above-identified Office action, Claims 9 to 16 have been rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No, 5,432,321 to Gerl in view of JP 61119922 to Nobuo et al. (hereinafter "Nobuo").

The rejection has been noted and Claim 8 has been amended in an effort to even more clearly define the invention of the

instant application. Support for the changes is found on pages 1 to 2 of the specification of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 8 calls for, *inter alia*, a cooking device, including:

> a first control unit regulating an upper heating unit and a hot-air heating unit; and
>
> a second control unit regulating temperature of a high-speed heating mode exclusively when the hot-air heating unit is operating and when the upper heating unit is switched on.

Neither Gerl nor Nobuo disclose or suggest the different control units where the second control unit regulates the high-speed heating mode only when both the hot-air heating unit and the upper heating unit are both activated.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and

the then-accepted wisdom in the field. *See In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.* (quoting *W.L. Gore & Assocs. Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most, if not all, inventions arise from a combination of old elements. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the claimed invention as a whole. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the appellant. *See In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion, or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *See Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. *See WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether an Examiner relies on an express or an implicit showing, **the Examiner must provide particular findings related thereto**. *See Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." *Id.* When an Examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. *See In re Lee*, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Here, the Examiner only provided the broad conclusory statement that the features of Nobuo can be incorporated into Gerl "because a grill heating unit allows for a more uniform heating." (It is noted that none of the references and the present application focus their teachings to a "uniform heating".)

Upon evaluation of the Office Action, it is respectfully believed that the evidence adduced is insufficient to establish a *prima facie* case of obviousness with respect to the claims.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in either Gerl or Nobuo.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either

show or suggest the features of Claim 9. Claim 9 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on Claim 9.

In view of the foregoing, reconsideration and allowance of Claims 9 to 16 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be agreed upon.

Please note, the enclosed Supplemental Application Data Sheet has been corrected to provide additional attorney contacts.

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Respectfully submitted

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